

## REMARKS

This Response is submitted in reply to the Office Action dated September 30, 2004. Claims 1, 13, 24 and 31 have been amended. No new matter has been added by any of these amendments. Claim 19 stands canceled without prejudice or disclaimer. Claims 29 to 38 stand allowed.

A Petition for a One Month Extension of Time to File the Response is submitted herewith. A check in the amount of \$120.00 is submitted herewith to cover the cost of the extension of time. Please charge deposit account number 02-1818 for any insufficiency of payment or credit any overpayment.

The Office Action rejected Claims 1, 13 and 24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action states that the elements of a multi-round game wherein (i) the determination of whether to assign an item to a symbol in one round is independent of other rounds, and (ii) items are assigned to different numbers of symbols in each round is contradictory. As discussed during the telephone interview, Applicants have amended Claims 1, 13 and 24 to clarify that the determination of whether to assign an item to a symbol in one round is independent of other rounds. Accordingly, Applicants respectfully submit that these rejections have been overcome and Claims 1, 13 and 24 are in condition for allowance.

Additionally, Applicants respectfully submit that Claim 1 has been amended to clarify that for each of the rounds, the player may be provided an award. This amendment has not been made to distinguish this claim over the prior art. Accordingly, Applicants respectfully submit that this amendment does not narrow the scope of the amended claim.

The Office Action rejected Claims 1, 2, 12, 13, 22 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Barrie in view of Feola and in view of Kamille.

Barrie relates to a gaming device wherein a player is displayed a plurality of choices or selections (i.e., doors). Each selection is randomly assigned one of a plurality of classes. The class assigned to each selection is either a reward class, a

lose class or a win class, wherein at least one of the selections must be assigned to a win class and at least one of the selections must be assigned to a lose class. In operation, the player is enabled to pick one of the plurality of choices or selections. If the class assigned to the picked selection is a reward class, the player is provided a reward and the game ends (page 2, lines 64 to 68). If the class assigned to the picked selection is a lose class, the game ends (page 2, lines 37 to 41). If the class assigned to the picked selection is a win class, the player is enabled to accept a designated reward or to attempt to obtain a larger reward and pick one of another plurality of choices or selections (page 2, lines 41 to 52). If the player accepts the designated reward, the player is provided the designated reward and the game ends. If the player chooses to pick one of another plurality of choices or selections, the game proceeds as described above until the player is provided a reward or a lose class is assigned to a player picked selection (page 2, lines 53 to 76).

Kamille relates to a gaming device for playing a selection game. Each game includes a number of concealed selections. In one embodiment, the game starts by the player selecting one spot or area. The selected spot is revealed to uncover either a directional symbol, a win symbol with an associated award or a lose symbol (col. 5, lines 61 to 67). If a directional symbol is revealed, taking the form of an arrow or pointer, the player is directed to select another specific spot or area with their next selection. The player's next selection is limited to the specific spot or area which the directional symbol indicates. If a lose symbol is revealed, the game ends. If a win symbol is revealed, the player is provided the award associated with the win symbol and the game ends. In one embodiment, each of the selections is associated with a win symbol, thus guaranteeing a winning outcome of the selection game. In another embodiment, each of the selections is associated with a void or lose symbol, thus guaranteeing a losing outcome of the selection game.

Feola relates to a multi-round card game wherein the outcome of one round is independent of the outcome of any prior round. In Feola, a player chooses a number of locations on a grid of hidden, randomly-selected cards, and uses the cards later revealed at these chosen locations and at other randomly selected locations to play a

number of different individual games, or rounds, wherein each round is independent of any other round.

Amended independent Claim 1 is directed to a gaming device including, amongst other elements, a plurality of independent rounds wherein a controller is operable to randomly determine for each of a plurality of the independent rounds whether to assign an item to at least one, a plurality of or all of the plurality of symbols, wherein the determination for each round is independent of the other rounds.

Applicants respectfully disagree with the combination of Barrie and Kamille and reiterate the reasoning as discussed in the previous Responses to Office Action dated August 12, 2003, January 7, 2004 and July 16, 2004. Applicants respectfully resubmit that by requiring that one symbol be assigned to a win class and one symbol be assigned to a lose class, Barrie teaches away from the feature of assigning one item to all of the symbols as disclosed in Kamille. Barrie teaches the need for at least two classes (i.e., items of the present invention) which must each be assigned to different doors (i.e., symbols of the present invention). On the other hand, if Barrie is combined with Kamille and a win class is associated with each symbol or a lose class is associated with each symbol, then the premise of Barrie (i.e., the opportunity of obtaining either a win class or a lose class with each symbol selection) would not be feasible. Accordingly, Applicants respectfully submit that Barrie and Kamille were improperly combined in rejecting Claims 1, 2, 12, 13, 22 and 23.

Applicants also respectfully disagree with the combination of Barrie and Feola and submit that the advancement along a path concept of Barrie teaches away from the independent round feature disclosed in Feola. The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device described by Barrie to include the independent round feature taught by Feola to make the game more exciting for players because a player can win in later rounds if he loses in earlier rounds. As discussed during the interview, Applicants respectfully disagree and submit that the independent round feature of Feola destroys the intended purpose and functionality of Barrie. As stated in the Office Action, in Barrie, the advancement to each subsequent round depends on the successful outcome

in a prior round. For example, if the player selects a door associated with a lose class, the game ends. However, as discussed during the telephone interview, if the independent rounds feature of Feola were combined with Barrie, then even if the player selects a door associated with a lose class, as each round (i.e., selection) is independent of earlier rounds, the game would not end and the gaming device would enable the player to pick another selection. In other words, Barrie includes a set of overall odds at the beginning of the game that are based on which classes are assigned to which selections in all of the possible rounds. These odds dictate that a certain percentage of plays on average will result in wins and a certain percentage of plays on average will result in losses. If the independent round feature of Feola were combined with Barrie, then the odds of each round (i.e., selection) would be independent of any other round and the overall odds set out at the beginning of the Barrie game would be meaningless. Accordingly, Applicants respectfully submit that combining the independent round feature of Feola into the advancement/path game of Barrie destroys the intended purpose and functionality of Barrie and is thus an improper combination.

Applicants respectfully submit that the Office Action ignores this and improperly relies on hindsight reasoning as a justification for the obviousness rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. MPEP §2145; *ATD Corp. v. Lydall*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998). When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. *In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000). As discussed during the telephone interview, the Office Action improperly used hindsight reasoning by combining a path/advancement game of Barrie with a series of independent events game of Feola. The Office Action used references

that each include only certain elements of Claim 1, but these references do not teach, disclose or suggest the specific combination of the elements of Claim 1. In this case, Barrie does not teach, disclose or suggest having each round independent of any previous round. Rather, as described above, Barrie teaches away from having each round independent of any previous round. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claim 1 and ignoring the intended purpose of Barrie, the Office Action improperly used hindsight reasoning as the basis for the obviousness rejection. For these reasons, Applicants submit that Claim 1 is patentably distinguished over Barrie, Feola and Kamille and in condition for allowance.

Claims 2 and 12 depend directly from Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Similar to amended independent Claim 1, amended independent Claim 13 is directed to a method for operating a gaming device including, amongst other elements, providing a plurality of independent rounds, wherein the determination in each of the rounds is independent of the other rounds. For the reasons stated above with respect to independent Claim 1, Applicants respectfully submit that amended independent Claim 13 is patentably distinguished over Barrie, Feola and Kamille and in condition for allowance.

Claims 22 and 23 depend directly from Claim 13 and are also allowable for the reasons given with respect to Claim 13, and because of the additional features recited in these claims.

The Office Action rejected Claims 3, 4, 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Barrie in view of Feola and Kamille in further view of Demar.

As discussed above with respect to Claim 1, Applicants respectfully submit that Barrie cannot be properly combined with Kamille, that Feola destroys the functionality of Barrie and that the Office Action relied on improper hindsight reasoning to form the basis of the obviousness rejection of Claims 3, 4, 11 and 12.

Additionally, Applicants respectfully submit that the Office Action improperly picked and chose elements from different references to form the basis of the obviousness rejection. An Office Action cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. *Akzo N.V. v. United States ITC*, 808 F.2d 1471 (Fed. Cir. 1986). The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In this case, the Office Action improperly picked elements from the references with different intended purpose to conclude that a gaming device having the elements of Claims 3, 4, 11 and 12 is obvious. The Office Action selectively picked specific elements from each of the different references without having a specific motivation for picking each element from each reference. This is an improper basis for the obviousness rejection of Claims 3, 4, 11 and 12. For these reasons, Applicants respectfully submit that Claims 3, 4, 11 and 12 are patentably distinguished over the combination of Barrie, Feola, Kamille and Demar and in condition for allowance.

The Office Action rejected Claims 14, 17 and 24 to 28 under 35 U.S.C. § 103(a) as being unpatentable over Barrie in view of Feola and Kamille, in further view of Yoseloff.

As discussed above with respect to Claims 3, 4, 11 and 12, Applicants respectfully submit that in addition to the Office Action improperly selectively picking and choosing elements from four different references, as described above, Barrie cannot be properly combined with Kamille, Feola destroys the intended purpose and functionality of Barrie and the Office Action relied on improper hindsight reasoning to form the basis for these rejections. For these reasons, Applicants respectfully submit that the Claims 14, 17 and 24 to 28 are patentably distinguished over the combination of Barrie, Feola, Kamille and Yoseloff and in condition for allowance.

The Office Action rejected Claims 5 to 10 and 15 to 21 under 35 U.S.C. § 103(a) as being unpatentable over Barrie in view of Feola, Kamille and Demar and in further view of Yoseloff.

As discussed above, Applicants respectfully submit that in addition to the Office Action improperly selectively picking and choosing elements from five different references, as described above, Barrie cannot be properly combined with Kamille, Feola destroys the intended purpose and functionality of Barrie and the Office Action relied on improper hindsight reasoning to form the basis for these rejections. For these reasons, Applicants respectfully submit that the Claims 5 to 10 and 15 to 21 are patentably distinguished over the combination of Barrie, Feola, Kamille, Demar and Yoseloff and in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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